

Inventor: Biaoyang Lin  
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Group II, claims 9 to 12, directed to a PAMP polypeptide and fragments thereof;

Group III, claims 13 to 20 and 24, directed to diagnostic methods that rely on a PAMP nucleic acid probe; and

Group IV, claims 21 to 23 and 25, directed to diagnostic methods in which the expression level of a PAMP polypeptide is measured.

The Office Action also indicates that Groups III and IV include multiple patentably distinct species, as follows:

1. Diagnosing a prostate neoplastic condition;
2. Diagnosing metastatic prostate cancer; and
3. Predicting susceptibility to a prostate neoplastic condition.

Applicant traverses the Restriction and Election of Species Requirements for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicant elects Group II, claims 9 to 12, for examination.

Applicant traverses the Restriction Requirement and respectfully points out that two separate requirements must be met in order for restriction to be proper. First, the inventions must be independent or distinct. Secondly, there must be a serious burden on the Examiner if restriction is required. See,

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for example, MPEP 803 (Restriction- When Proper), which states, in part:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Page 800-3; emphasis added.

Thus, it is not sufficient for an Examiner to assert that patentably distinct inventions are present in order to restrict an application or require an election of species. There also must be a serious burden on the Examiner to search and examine the entire application. In the present case, Group II is directed to a PAMP polypeptide or fragment thereof, and Group IV is directed to diagnostic methods that involve determining an expression level of a PAMP polypeptide. Thus, Applicant submits that the subject matter of Group II, while patentably distinct from the methods of Group IV, is related to these methods and that no serious burden is imposed on the Examiner to search and examine both groups of claims. Furthermore, Applicant asserts that a thorough search of the subject matter of Group II likely will result in discovery of any art relevant to the claims of Group IV. Thus, searching and examining both groups of claims together will avoid a duplicative effort on the part of the Patent and Trademark Office.

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In summary, the claims of Group II, while patentably distinct from the claims of Group IV, are related such that searching and examining both groups does not impose a serious burden on the Examiner. It is respectfully requested that the Examiner reconsider the Restriction Requirement in regard to restriction of Group II from Group IV.

Similarly, Applicant respectfully traverses the Election of Species Requirement issued in connection with Groups III and IV. Each of the claims of Group III, and each of the claims of Group IV, while patentably distinct, have the same method steps. Applicants submit that there is significant overlap in the work required to search and examine the separate species of Group III, or the separate species of Group IV, and that the work required to search all the species having the same method steps cannot be considered to represent a "serious burden." Applicant therefore respectfully requests that the Examiner reconsider the Election of Species Requirement issued in regard to Group III and Group IV.

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### III. CONCLUSION

Applicant appreciates the Examiner's reconsideration of the Restriction and Election of Species requirement. The Examiner is requested to call the undersigned agent or Cathryn Campbell if there are any questions regarding this application.

Respectfully submitted,

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